

Section III:
AMENDMENT UNDER 37 CFR §1.121 to the
DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Reconsideration of Previous Rejections

We appreciate the Examiner's reconsideration and withdrawal of the Rejections under 35 U.S.C. §102(e) over Kramer.

Rejections under 35 U.S.C. §112, Second Paragraph

User ID and User Ethnicity, Age, Gender and Income Level. In the reasons for this rejection, the Examiner has noted our disclosure passages which indicate the user's identity is determined using a method such as URL rewriting, depositing/retrieving of cookies, or receiving a user profile which was created by the user during registration, and has noted where our disclosure indicates that well-known user registration processes can collect user ethnicity, age, gender and income level information.

We are submitting herewith a supplemental IDS showing knowledge in the art of how to identify a user using URL rewriting, cookies, and user profiles (e.g. session tracking and/or user authentication), as well as documents that show it is well known in the art how to collect and store demographic data regarding individual users or groups of users.

We have amended Claim 1 to recite reception of this user demographic information, which may be received from any of the traditional sources such as a registration process, online user profiles, registration databases, etc.

Effectiveness Data. We have deleted this recitation from Claim 1.

New, Previously Non-existing Composite Advertisement. By new and previously non-existing, we were emphasizing the aspect of our claimed process which dynamically creates the composite ad *responsive to a page request*, as opposed to processes which create variations of ads *before* a page request is received. In review, we ask the Examiner to note that this step is qualified by "*responsive to a web page request from a user of a web browser: . . .*", and that it recites use of the selected model image and background image, thus it must be subsequent to those steps as well. As such, we believe the phrase "new, previously non-existing . . ." was redundant. So, we have deleted it from Claim 1, and replaced it with *dynamic generation* of an

ad (TITLE, ABSTRACT, paras. [0001], [0018], [0022], [0025], etc.).

Request for Suggested Language. The claims are not required to enable one of ordinary skill in the art (Miles Lab., Inc. v. Shandon Inc., 997 F.2d 73, 70 USPQ 32 (D.C. Cir. 1946)), and the claims are not required to provide a written description (Orthokinetics Inc. v. Safety Travel Chairs Inc., 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986)). If the Examiner does not find the present amendment insufficient for overcoming the rejections under 35 U.S.C. §112, second paragraph, we would greatly appreciate suggestions for claim language from the Examiner (MPEP §2173.02).

Rejections under 35 U.S.C. §103(a)

As we best understand the reasons for rejection, the two Gatarski documents from 1998 and 1999 are being treated as a single reference because they refer to the same project, the latter document being an update to the earlier document. They are not, as we understand it, being presented as a combination under 35 U.S.C. §103(a).

We respectfully disagree with the Examiner regarding Gatarski's teachings of demographic image characteristics such as the gender, age, income level or ethnicity *of the web browser user* (e.g. of the person to whom the banner ad will be shown). Rather, the citations provided by the Examiner refer to a variety of genetic algorithm parameters, but these are not referring to the genetics of the user to whom the banner ad will be shown. The genes, alleles, and chromosomes disclosed by Gatarski are analogous in a programming style to their counterparts in biology which allows a programmer to see the similarity between the *random* ('98, pg. 5 last paragraph, pg. 9 last paragraph, etc.) combination and evolutionary-like natural selection processes employed by the genetic algorithm. However, there is no disclosure, in our opinion, in Gatarski which accesses or receives *demographic* information about the user to whom the dynamically created banner will be shown.

Please note also that it appears that all of the variations of placement of objects in their banner ads are produced automatically, but not responsive to a page request, instead, they are produced in advance of running their tests.

We also ask the Examiner to please consider that Gatarski states explicitly that identification of a user is undesirable ('99, pgs. 1 and 2, our emphasis added):

... They also note technical problems (imprecise log files, sites in a network, visitor identification) that restrict the modeling scope. Drèze and Zufryden (1998) studied the nature and magnitude of errors in Web-based advertising research caused by problems regarding the **identification of unique visitors**, caching and never read/received messages. They concluded that there were significant problems to be resolved before Internet advertising is "ready for prime time" and comparable with standard media. Market researchers have since long used multivariate data analysis to cope with complex setups.

...

But their multiple step approaches demand **longitudinal identification of the visitors**. The cost of implementation and the sophistication of the underlying ideas might also scare away practitioners (Carroll and Green, 1995). Furthermore those methodologies do not consider important effects such as ad clutter, war in and banner burnout (Chatterjee et al., 1998).

Regarding Gatarski '98's disclosure of AltaVista performing an automatic check of a visitor's nationality and presenting a banner ad featuring a product from the visitor's own country in the visitor's language, we must disagree that this is an enabling disclosure. It does not state how this automatic check is done. Moreover, determining a user's nationality is not the same as determining a user's ethnicity, income level, age, or gender, as each country has a variety of ethnic groups, ages of citizens, both genders, and ranges of incomes. Since it is well known that Alta Vista does not require user profiles or registration to use their search engine, it is unclear how Alta Vista would determine a user's ethnicity, income level, age, or gender solely from knowing their nationality.

We believe it is unlikely that one of ordinary skill in the art would interpret Gatarski's described genetic algorithm process for generating banner ads to use any sort of user identification in view of these dissuasive comments from Gatarski. Instead, we believe Gatarski's disclosure is clear that it *avoids* the need to identify the user by use of randomization and genetic-like mutation processes to select better and more effective banner ads.

For these reasons, we respectfully request reconsideration and allowance of Claim 1 as amended.

Request for Indication of Allowable Subject Matter

We believe we have responded to all grounds of rejection and objection, but if the Examiner disagrees, we would appreciate the opportunity to supplement our reply.

We believe the present amendment places the claim in condition for allowance. If, for any reason, it is believed that the claim is not in a condition for allowance, we respectfully request constructive recommendations per MPEP 707.07(j) II which would place the claim in condition for allowance without need for further proceedings. We will respond promptly to any Examiner-initiated interviews or to consider any proposed examiner amendments.

Respectfully,

/ Robert Frantz /

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